

## **REMARKS/ARGUMENTS**

The Office Action has been carefully considered. It is respectfully submitted that the issues raised are traversed, being hereinafter addressed with reference to the relevant headings appearing in the Detailed Action section of the Office Action.

### ***Claim Objections***

At paragraph 2 of the Office Action, the Examiner has objected to claim 34 as being improper form because a multiple dependent claim must refer in the alternative only. In view of this, claim 34 has been cancelled. We therefore respectfully request reconsideration and withdrawal of this objection.

### ***Claim Rejections – 35 USC § 102***

At page 2 of the Office Action, the Examiner has rejected claims 1-11, 13, 15-21, 31 and 32 as being anticipated by Kawai et al (US Patent Number 5,128,527).

In particular, the Examiner has stated at paragraph 4 that *"the UPC itself identifies the product, i.e. second identifier indicative of the item. The add-on code identifies a family of products, i.e. class of products."*

We respectfully submit that Kawai et al does not show each coded data portion being indicative of an identity of the product item. As the Examiner has stated, the second coded data portion being the add-on code identifies a family of products, not the identity of the product itself. Thus the add-on code does not distinguish one product item from another.

In order to clarify this distinction, we have amended claim 1 to incorporate subject matter from claim 3 to specify *"that the identity distinguishes the product item from each other product item."* Subsequently claim 3 has been cancelled. Claim 33 has also been amended similarly to claim 1.

Clearly Kawai et al cannot be considered to anticipate amended claim 1 as the identity of the add-on code disclosed in Kawai et al is indicative of an identity of a family of products, which contrasts to claim 1 which specifies that each identity of each coded data portion distinguishes the product item from each other product item.

Reconsideration and withdrawal of the rejection is respectfully requested.

***Claim Rejections – 35 USC § 103***

At paragraph 7 of the Office Action, the Examiner has rejected claims 12, 22-24 and 26-29 as being unpatentable over Kawai et al.

Obviousness can only be established by combining or modifying teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

In particular, the MPEP states at §2143 "*Basic Requirements of a Prima Facie Case of Obviousness*" that:

*"... three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.*

*The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."*

As claim 1 has been amended to specify that the identity of each coded data portion distinguishes the product item from other product items, we respectfully submit that Kawai et al does not teach or suggest all the claim limitations of amended claim 1. As all claim limitations have not been taught or suggested by the cited document, and as Kawai et al does not provide any suggestion or motivation to provide an identity in each coded data which distinguishes the product item from other product items, we respectfully submit that a prima facie case of obviousness should not be maintained in view of the first and third basic requirements stated at §2143 of the MPEP.

Reconsideration and withdrawal of the rejection is respectfully requested.

We have also inserted new independent claims 35 and 36. Claim 35 is a combination of subject matter from claims 1 and 14. Claim 36 is a combination of subject matter of claims 1 and 25. The Examiner has indicated at paragraph 9 of the Office Action that these claims would be allowable if rewritten in independent form. Therefore, we respectfully submit that claims 35 and 36 are not anticipated and are patentable over Kawai et al.

**CONCLUSION**

In view of the foregoing, it is respectfully requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a). The present application is believed to be in condition for allowance. Accordingly, the Applicant respectfully requests a Notice of Allowance of all the claims presently under examination.

Very respectfully,

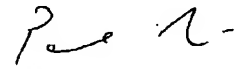
Applicant:



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KIA SILVERBROOK

Applicant:



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PAUL LAPTSUN

C/o: Silverbrook Research Pty Ltd  
393 Darling Street  
Balmain NSW 2041, Australia

Email: [kia.silverbrook@silverbrookresearch.com](mailto:kia.silverbrook@silverbrookresearch.com)

Telephone: +612 9818 6633

Facsimile: +61 2 9555 7762